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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,936	08/18/2000	Detlef Pickert	11150/8	6338

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EXAMINER	
MCCALL, ERIC SCOTT	
ART UNIT	**PAPER NUMBER**
2855	

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/530,936	Applicant(s) PICKERT ET AL.	
	Examiner Eric S. McCall	Art Unit 2855	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.
8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☒ Other: *See Continuation Sheet*

Eric S. McCall
Primary Examiner
Art Unit: 2855

Continuation of 5. does NOT place the application in condition for allowance because: With regards to the rejection under 35 USC 112, first paragraph, as stated in the final office action (7/03/03), the step of "indirectly" determining and evaluating a change of the viscosity of motor oil is not described in the specification in such a way as to reasonably convey to one skilled in the art that the step was possessed by the Applicant when the application was filed. In other words, one having ordinary skill in the art would have no reason to believe that the Applicant's approach is that of an "indirect" approach, as now claimed, because not only has the Applicant not disclosed such, but the Applicant has not reasonably suggested such. In short, there is no suggestion in the Applicant's specification that the approach is "indirect" as now claimed.

The Applicant has argued that the initial burden of presenting evidence as to why persons skilled in the art would not recognize the claimed "indirect" approach falls on the office. As such, the Examiner points out, as in the previous office action, that a person skilled in the art would not recognize such because (1) no clear statement has been set forth in the Applicant's disclosure as of such an indirect approach and (2) there is no suggestion by the Applicant of such an indirect approach. Thus, one skilled in the art would have no reason to believe that the Applicant's approach is that of an "indirect" approach.

Next, the Applicant has cited specific citations from the specification in support of their argument. First, the Applicant points to page 1, lines 21-28. However, the Examiner points out that said citation is with regards to the prior art as known by the Applicant and not the Applicant's invention. Furthermore, the Applicant has failed to take into account earlier amendments to said citation because the citation as stated by the Applicant is not correct (ie. it has earlier been amended).

Next, the Applicant points to page 2, line 27 through page 3, line 5 as support to their argument. In response, the Examiner points out that not only does said citation not disclose such an "indirect" method but, in fact, teaches away from an indirect method. Specifically, said passage sets forth the Applicant's invention is directed to a method of monitoring and determining oil quality in a "simple and accurate manner", and that the method is achieved by determining and evaluating changes in oil viscosity "as a function of temperature and frictional torque". Thus, the Examiner reasons that a "simple and accurate manner" is that of a direct approach and not an indirect approach. A "simple" manner is a straight forward manner and thus a direct manner. An indirect approach, on the other hand, is not straight forward but one that involves a round-about way and thus one that is not "simple". Furthermore, the disclosure that the determining and evaluating changes in oil viscosity is a function of temperature and frictional torque also supports the Examiner's position because oil viscosity is very dependent on temperature and frictional torque. Thus, to determine viscosity from said parameters would be a "direct" approach.

With regards to the rejection under 35 USC 112, second paragraph, the Applicant's arguments have been considered but have not been found to be persuasive.

With regards to the rejection under 35 USC 103, the Applicant's arguments have been considered but have not been found to be persuasive.

Continuation of 10. Other: Applicant's formal drawings of figs 1 & 2 have been approved and entered into the application..